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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,470	09/20/2001	Richard Francis Russell	2001-0157.02	1706

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EXAMINER
REFAI, RAMSEY

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/960,470	RUSSELL ET AL.
	Examiner	**Art Unit**	
	Ramsey Refai	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 February 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Responsive to Amendment received on February 17, 2005.

        Claims 1-12 are pending further examination.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter, which the applicant regards as his invention.

3.   Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Claim 9 recites the limitation "the method of claim 8" in line 1. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claims 8-9 are rejected under 35 U.S.C. 101 because these claims are directed to non-

statutory subject matter as being drawn to a program per se. Programs per se are not one of the

statutory classes of invention. Programs must be tangibly embodied on a computer readable

medium and be drawn to a practical application in order to be eligible for patent protection.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et

al (U.S. Patent No. 6,496,859) in view of White et al (6,301,012).

7.   As per claim 1, Roy et al teach a method comprising the steps of:

providing a network **(Figure 1 and column 3, lines 27-37);**

communicatively coupling said computer workstation to said network **(Figure 1 and**

column 3, lines 27-37);

communicatively coupling at least one printer to said network **(Figures 5A-5B);**

said computer workstation performing the steps of:

transmitting a discovery packet to which a first printer of a designated type can

respond **(column 3, lines 27-50 and column 2, lines 31-51);**

receiving a response packet from said first printer, said response packet including

printer-specific network information of said first printer **(column 2, lines 14-51 and**

Figure 4).

8.   Roy et al fails to teach identifying whether a network port exists for said first printer and

if no such network port exists, then creating a first network printer port for said first printer based

on said printer-specific network information for said first printer.

9.   However, White et al teach receiving identification data for identifying a peripheral

device, and if the peripheral device is a new device on the network, automatically creating

communication port **(abstract, column 2, lines 11-28, Figure 3, and column 4, lines 17-27)**. It

would have been obvious to one of the ordinary skill in the art at the time of the applicant's

invention to combine the teachings of Roy et al and White because White's use of creating a port

for newly identified devices in Roy et al's method would allow a user to send a discovery packet

to discover network printers and once a response with printer-specific network information is

received, a port is automatically created so that a user can use the new network printer.

10.   As per claims 6, and 9, Roy et al teach printer-specific network information includes a

TCP/IP address and a MAC address **(column 2, lines 8-11 and column 8, lines 7-10)**.

11.   As per claim 7, Roy et al teach a discovery packet is a propriety broadcast message to

which only a printer of said designated type on said network will respond **(column 2, lines 31-

43)**.

12.   As per claim 8, this claim contains similar limitations as claim 1 above, therefore is

rejected under the same rationale.

13.   Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al

(U.S. Patent No. 6,496,859) in view of White et al (6,301,012) and in further in view of

Brockway et al (U.S. Patent No. 6,789,111).

14.   As per claim 2, Roy et al fail to explicitly teach initializing a port monitor upon a loading of said print subsystem, said port monitor performing each of said transmitting step, said receiving step and said identifying step.

15.   However, Brockway et al teach a Plug and Play subsystem on a client computer that monitors ports, detects the presence of peripheral devices, notify the computer when new device are connected to the system, identify the peripheral devices, and configure the computer to operate in conjunction with the peripheral device **(column 5, lines 62-column 6, lines 25)**. It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Roy et al, White et al, and Brockway et al because Brockway et al's use of a Plug and Play subsystem in Roy et al and White et al's method would allow a client computer to discover new devices, such as printers, by monitoring ports, and if no port for the device is available, create a port to allow a user to communicate with the newly discovered device.

16.   As per claim 3, Roy et al teach an operating system is a WINDOWS operating system **(column 6, line 15-18)**.

17.   As per claim 4, Roy et al fail to explicitly teach a WINDOWS operating system includes a print spooler for initializing said port monitor and for performing said creating step.

18.   However, Brockway et al teach a Plug and Play subsystem, on a client computer using a WINDOWS 2000 operating system **(column 4, lines 45-50; it is known in the art that**

WINDOWS 2000 contains a printer spooler), that monitors ports, detects the presence of

peripheral devices, notifies the computer when new device are connected to the system, installs

drivers, identifies devices and network information, and configures the computer to operate in

conjunction with the peripheral device **(column 5, lines 62-column 6, lines 25).** It would have

been obvious to one of the ordinary skill in the art at the time of the applicant's invention to

combine the teachings of Roy et al, White et al, and Brockway et al because Brockway et al's

use of a Plug and Play subsystem in Roy et al and White et al's method would allow a client

computer to discover new devices, such as printers, by monitoring ports, and if no port for the

device is available, create a port to allow a user to communicate with the newly discovered

device.

19.   As per claim 5, Roy et al fail to teach said print spooler receives said printer-specific

network information for said first printer from said port monitor.

20.   However, Brockway et al teach a Plug and Play subsystem, on a client computer using a

WINDOWS 2000 operating system **(column 4, lines 45-50; it is known in the art that**

WINDOWS 2000 contains a printer spooler), that monitors ports, detects the presence of

peripheral devices, notifies the computer when new device are connected to the system, installs

drivers, identifies devices and network information, and configures the computer to operate in

conjunction with the peripheral device **(column 5, lines 62-column 6, lines 25; print spooler**

would obtain device information from the port monitor (Plug and Play system)) It would

have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to

combine the teachings of Roy et al, White et al, and Brockway et al because Brockway et al's

use of a Plug and Play subsystem in Roy et al and White et al's method would allow a client

computer to discover new devices, such as printers, by monitoring ports, and if no port for the

device is available, create a port to allow a user to communicate with the newly discovered

device.

21.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable by Brockway et al

(U.S. Patent No. 6,789,111) in view of Roy et al (U.S. Patent No. 6,496,859) and in further view

of White et al (U.S. Patent No. 6,301,012).

22.   As per claim 10, Brockway et al teach a method for automatically creating a network

printer port on a workstation connected to a network, comprising the steps of:

providing a Windows operating system at said workstation **(column 4, lines 45-50)**, said

Windows operating system including a print subsystem **(column 5, lines 10-35 and column 5,**

line 62-column 6, line12; plug and play subsystem);

providing a Windows print spooler at said workstation having an Add Port mechanism

column 5, lines 10-35, column 4, lines 51-62, column 5, line 62-column 6, line12; it is known

in the art that WINDOWS 2000 operating system contains a printer spooler);

providing a port monitor at said workstation; involking said Windows print spooler to

initialize said port monitor peripheral device **(column 5, lines 62-column 6, lines 25; print**

spooler would obtain device information from the port monitor (Plug and Play system)).

23.   Brockway et al fail to explicitly teach sending a proprietary broadcast message to which

each printer of a designated type on said network can respond, said each printer of said

designated type responding to said proprietary broadcast message with a unique data packet

including printer-specific network information; said port monitor receiving said printer-specific

information; and for each identified printer of said designated type for which no port exists, said

port monitor invoking a said Add Port mechanism of said Windows print spooler and thereafter,

said port monitor passing said printer-specific network information to said Windows print

spooler for creation of said network printer port on said workstation.

24.   However, Roy et al teach transmitting a discovery packet to which a first printer of a

designated type can respond **(column 3, lines 27-50 and column 2, lines 31-51)**; receiving a

response packet from said first printer, said response packet including printer-specific network

information of said first printer **(column 2, lines 14-51 and Figure 4)**.

25.   Roy et al fail to teach identifying whether a network port exists for said first printer and

if no such network port exists, then creating a first network printer port for said first printer based

on said printer-specific network information for said first printer.

26.   However, White et al teach receiving identification data for identifying a peripheral

device, and if the peripheral device is a new device on the network, automatically creating

communication port **(abstract, column 2, lines 11-28, Figure 3, and column 4, lines 17-27)**. It

would have been obvious to one of the ordinary skill in the art at the time of the applicant's

invention to combine the teachings of Brockway et al, Roy et al, and White et al because doing

so would allow a client's computer to discover new devices, such as printers, by monitoring

ports, and if no port for the device is available, create a port to allow a user to communicate with

the newly discovered device.

27.   As per claim 11, Brockway et al fail to teach printer-specific network information

includes a TCP/IP address and a MAC address.

28.   However, Roy et al teach printer-specific network information includes a TCP/IP address

and a MAC address **(column 2, lines 8-11 and column 8, lines 7-10).** It would have been

obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine

the teachings of Brockway et al, Roy et al, and White et al because doing so would allow a

client's computer to discover new devices , such as printers, by sending discover packets, and

obtaining a response that contains identification of a device, such as a printer's MAC and/or IP

address. Then monitoring ports, and if no port for the device is available, create a port to allow a

user to communicate with the newly discovered device.

29.   As per claim 12, Brockway et al teach the step of invoking said WINDOWS print spooler

to initialize said port monitor occurs when said print subsystem is loaded by said workstation

(column 4, lines 45-50; it is known in the art that WINDOWS 2000 contains a printer

spooler).

Response to Arguments

30.   Applicant's arguments have been considered but are moot in view of the new ground(s)

of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

    a.   Nelson et al (U.S. Patent No. 5,835,720)

    b.   Wu (U.S. Patent No. 5,185,860)

    c.   Cromer et al (U.S. Patent No. 6,493,104)

     d.   Shaffer et al (U.S. Patent No.6,249,814)

     e.   Onaga (U.S. Patent No. 5,862,404)

     f.   Agatone et al (U.S. Patent No. 5,852,744)

     g.   Wiley et al (U.S. Patent No. 5,687,320)

     h.   Lafky (U.S. Patent No. 6,809,830)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                                          Ramsey Refai
                                          Examiner
                                          Art Unit 2154

RR

May 4, 2005